

Notice of Allowability

Application No.

09/575,193

Applicant(s)

SILVERBROOK ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/13/2005
2. ☒ The allowed claim(s) is/are 1,2,4,5,7,11,15,18,26,31-34,37,45 and 61.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/2005 has been entered.

Claims 1-2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, and 61 are pending.

Allowance

2. Applicants' arguments have been persuasive. Claims 1-2, 4-5, 7, 11, 15, 18, 26, 31-34, 37, 45, and 61 are allowed.

3. The following is an examiner's statement of reasons for allowance: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art at the time of the invention

“a printer that is connected to the network, the printer being operable to print said first information on a first sheet with both visible and invisible ink such that the first information includes at least one identifier in invisible ink, representing a request to the printer to retrieve the second information from the second data storage device and to print said second information on a second sheet;

....

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a reader that is connected to the interface module and is **capable of reading the, or each, identifier to generate a request for the second information such that the printer generates the second sheet carrying said second information;**

in conjunction with all the other limitations of independent claims 1, 26, and 31.

The closest non-patent literature prior art is :

“Intelligent Paper” by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, herein “Intelligent Paper”.

It discloses interactive paper and networks to interact therewith but does not disclose

“a printer that is connected to the network, the printer being operable to print said first information on a first sheet with both visible and invisible ink such that the first information includes at least one identifier in invisible ink, representing a request to the printer to retrieve the second information from the second data storage device and to print said second information on a second sheet;

....

a reader that is connected to the interface module and is **capable of reading the, or each, identifier to generate a request for the second information such that the printer generates the second sheet carrying said second information;**

in conjunction with all the other limitations of independent claims 1, 26, and 31.

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The closest US patent prior art is: US 5692073 to Cass,. It discloses formless forms and paper web using a reference-based mark extraction technique, including uses of interactive papers over the Internet, but it does not disclose

“a printer that is connected to the network, the printer being operable to print said first information on a first sheet with both visible and invisible ink such that the first information includes at least one identifier in invisible ink, representing a request to the printer to retrieve the second information from the second data storage device and to print said second information on a second sheet;

....

a reader that is connected to the interface module and is capable of reading the, or each, identifier to generate a request for the second information such that the printer generates the second sheet carrying said second information;

in conjunction with all the other limitations of independent claims 1, 26, and 31.

The closest foreign prior art is : UK Patent Application GB 2306669A to Gregory J. Wolff et al. it discloses interactive paper and e-document handling and processing system but does not disclose

“a printer that is connected to the network, the printer being operable to print said first information on a first sheet with both visible and invisible ink such that the first information includes at least one identifier in invisible ink, representing a request to the printer to retrieve the second information from the second data storage device and to print said second information on a second sheet;

....

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a reader that is connected to the interface module and is **capable of reading the, or each, identifier to generate a request for the second information such that the printer generates the second sheet carrying said second information;**

in conjunction with all the other limitations of independent claims 1, 26, and 31.

4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

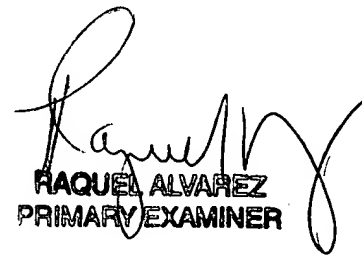
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 20, 2006

FM
KHL


RAQUEL ALVAREZ
PRIMARY EXAMINER